

**REMARKS**

Claims 1-30 are presently pending, of which Claims 1-14, 20, and 30 have been withdrawn from consideration. Claims 31-34 have been added herein. Support for these claims is found at least at page 1, lines 18-19; page 2, lines 14-15; page 3, lines 9-12; page 6, lines 18-21; page 8, lines 22-23; page 12, lines 8-11; and originally filed Claims 7-9. No new matter has been added.

**Rejection under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected Claims 17 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner notes that Claim 17 should depend from Claim 15 for proper dependency. With respect to Claim 24, the Examiner states that the recitation "can emit" is unclear and should be rephrased as --emits-- if the UV source is being specified.

Claim 17 has been amended to depend from Claim 15 and Claim 24 has been amended to recite that "said radiation source emits ultraviolet light". It is believed that all the pending claims fully comply with 35 U.S.C. § 112, second paragraph.

**Rejection under 35 U.S.C. § 102(b)**

The Examiner rejected Claims 23, 28, and 29 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP8137375 ('375 Patent).

Independent Claim 23 of the present application specifically recites that the radiation curable material is connected to a base disposed between the radiation curable material and the pattern for blocking a portion of the radiation. The Examiner acknowledges that the '375 Patent does not disclose this limitation, but that "this aspect constitutes a functional limitation which the prior art structure is inherently capable of performing." As set forth in *Ex Parte Levy*, 17

U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art" (emphasis original). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

It is respectfully submitted that the allegedly inherent characteristic of having the base disposed between the material and the pattern does not necessarily flow from the teachings of the '375 Patent, based on the translated Abstract. There is no indication in the Abstract of the '375 Patent that the base 2 is transparent to the light 6. The fact that the base could be placed between the radiation curable material and the pattern of the '375 Patent is not sufficient to establish inherency.

The '375 Patent describes a process wherein a photosensitive resin composition layer 1 is provided on a base 2. A mold 3 is brought into contact with the layer 1 and heat and pressure is used to form relief patterns 4. The mold 3 is apparently removed and the patterns 4 are then subject to irradiation with light 6 via an arbitrary mask 5, by which regions partially varying in the degree of curing are formed. The relief image forming material formed with the cured regions partially varied in the degree of curing is softened and deformed by heating at a specific temperature, by which visually checkable contrasts are generated between the cured regions varying in the degree of curing. The deformed patterns are thereafter fixed by applying full-surface exposure thereon.

The discernible pattern of Claim 23 can be formed in one step wherein the masked and unmasked areas are cured at about the same time. The cured structures are all about the same

shape as the mold, but contain a subtle secondary pattern of the pointed mask where the image had been between the radiation source and the radiation curable material.

Thus, the rejection is respectfully traversed.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected Claims 15-21 and 23-29 as being unpatenable over the '375 Patent in view of Martens (U.S. Patent 4,576,850).

The Examiner looks to Martens to show a transparent base disposed between a lamp and the material to continuously form an optical structure. Although the Examiner is correct in this assertion, there is still no teaching or suggestion in Martens of forming differentially-cured structures in a continuous fashion. Additionally, there does not appear to be any teaching or suggestion in the '375 Patent of continuously forming in a radiation curable material a pattern that includes a first cured portion cured to a first amount and a second cured portion cured to a second amount with the first amount being sufficiently different than the second amount to result in a visible discontinuity on the surface of the structure.

Thus, the rejection with respect to independent Claims 15 and 27 is respectfully traversed.

Independent Claim 23 recites that the radiation curable is connected to a base disposed between the radiation curable material and the pattern. Although Martens appears to disclose this limitation, there is no teaching or suggestion of using a pattern to form a discernible pattern in a radiation curable material, wherein the discernible pattern includes a first cured portion cured to a first amount and a second cured portion cured to a second amount. Again, there is no teaching or suggestion of combining the teachings of the '375 Patent and Martens in such a way so as to render the claims of the present application obvious.


Accordingly, the rejection is respectfully traversed.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner believes that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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